



RECEIVED

JUN 08 2001

AP/1642

Please type a plus sign (+) inside this box → 

TECH CENTER 1600/2800

PTO/SB/21 (08-00)  
Approved for use through 10/31/2002. OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

<b>TRANSMITTAL FORM</b> (to be used for all correspondence after initial filing)		<b>Application Number</b> <b>08/644,289</b> <b>Filing Date</b> <b>May 10, 1996</b> <b>First Named Inventor</b> <b>Molly F. Kulesz-Martin</b> <b>Group Art Unit</b> <b>1642</b> <b>Examiner Name</b> <b>M. Davis</b>
Total Number of Pages in This Submission	<b>14</b>	<b>Attorney Docket Number</b> <b>RPP:135D US</b>

### ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached  <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s)  <input type="checkbox"/> Extension of Time Request  <input type="checkbox"/> Express Abandonment Request  <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s)  <input type="checkbox"/> Response to Missing Parts/ Incomplete Application  <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application)  <input type="checkbox"/> Drawing(s)  <input type="checkbox"/> Licensing-related Papers  <input type="checkbox"/> Petition  <input type="checkbox"/> Petition to Convert to a Provisional Application  <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address  <input type="checkbox"/> Terminal Disclaimer  <input type="checkbox"/> Request for Refund  <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group  <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences  <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)  <input type="checkbox"/> Proprietary Information  <input type="checkbox"/> Status Letter  <input type="checkbox"/> Other Enclosure(s) (please identify below):
<b>Remarks</b>		

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	<b>Michael L. Dunn</b> <b>Dunn &amp; Associates</b>		
Signature			
Date	<i>June 04, 01</i>		

### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: *June 01, 01*

Typed or printed name	<b>Michael L. Dunn</b>		
Signature		Date	<i>June 4, 01</i>

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>FEE TRANSMITTAL</b> <b>for FY 2001</b>		Complete if Known																																																																																																																																																																																																								
		Application Number <b>08/644,289</b> Filing Date <b>May 10, 1996</b> First Named Inventor <b>Molly F. Kulesz-Martin</b> Examiner Name <b>M. Davis</b> Group Art Unit <b>1642</b> Attorney Docket No. <b>RPP:135D US</b>																																																																																																																																																																																																								
<b>TOTAL AMOUNT OF PAYMENT</b> (\$)																																																																																																																																																																																																										
<b>METHOD OF PAYMENT</b>		<b>FEE CALCULATION (continued)</b>																																																																																																																																																																																																								
1. <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge indicated fees and credit any overpayment to: Deposit Account Number <b>04-1790</b>  Deposit Account Name <b> </b>		<b>3. ADDITIONAL FEES</b> <table border="1"> <thead> <tr> <th rowspan="2">Fee Code</th> <th colspan="2">Large Entity</th> <th colspan="2">Small Entity</th> <th rowspan="2">Fee Description</th> <th rowspan="2">Fee Paid</th> </tr> <tr> <th>Fee (\$)</th> <th>Fee Code</th> <th>Fee (\$)</th> <th>Fee Code</th> </tr> </thead> <tbody> <tr><td>105</td><td>130</td><td>205</td><td>65</td><td>Surcharge - late filing fee or oath</td><td> </td></tr> <tr><td>127</td><td>50</td><td>227</td><td>25</td><td>Surcharge - late provisional filing fee or cover sheet</td><td> </td></tr> <tr><td>139</td><td>130</td><td>139</td><td>130</td><td>Non-English specification</td><td> </td></tr> <tr><td>147</td><td>2,520</td><td>147</td><td>2,520</td><td>For filing a request for ex parte reexamination</td><td> </td></tr> <tr><td>112</td><td>920*</td><td>112</td><td>920*</td><td>Requesting publication of SIR prior to Examiner action</td><td> </td></tr> <tr><td>113</td><td>1,840*</td><td>113</td><td>1,840*</td><td>Requesting publication of SIR after Examination action</td><td> </td></tr> <tr><td>115</td><td>110</td><td>215</td><td>55</td><td>Extension for reply within first month</td><td> </td></tr> <tr><td>116</td><td>390</td><td>216</td><td>195</td><td>Extension for reply within second month</td><td> </td></tr> <tr><td>117</td><td>890</td><td>217</td><td>445</td><td>Extension for reply within third month</td><td> </td></tr> <tr><td>118</td><td>1,390</td><td>218</td><td>695</td><td>Extension for reply within fourth month</td><td> </td></tr> <tr><td>128</td><td>1,890</td><td>228</td><td>945</td><td>Extension for reply within fifth month</td><td> </td></tr> <tr><td>119</td><td>310</td><td>219</td><td>155</td><td>Notice of Appeal</td><td> </td></tr> <tr><td>120</td><td>310</td><td>220</td><td>155</td><td>Filing a brief in support of an appeal</td><td> </td></tr> <tr><td>121</td><td>270</td><td>221</td><td>135</td><td>Request for oral hearing</td><td> </td></tr> <tr><td>138</td><td>1,510</td><td>138</td><td>1,510</td><td>Petition to institute a public use proceeding</td><td> </td></tr> <tr><td>140</td><td>110</td><td>240</td><td>55</td><td>Petition to revive - unavoidable</td><td> </td></tr> <tr><td>141</td><td>1,240</td><td>241</td><td>620</td><td>Petition to revive - unintentional</td><td> </td></tr> <tr><td>142</td><td>1,240</td><td>242</td><td>620</td><td>Utility issue fee (or reissue)</td><td> </td></tr> <tr><td>143</td><td>440</td><td>243</td><td>220</td><td>Design issue fee</td><td> </td></tr> <tr><td>144</td><td>600</td><td>244</td><td>300</td><td>Plant issue fee</td><td> </td></tr> <tr><td>122</td><td>130</td><td>122</td><td>130</td><td>Petitions to the Commissioner</td><td> </td></tr> <tr><td>123</td><td>50</td><td>123</td><td>50</td><td>Processing fee under 37 CFR 1.17(q)</td><td> </td></tr> <tr><td>126</td><td>180</td><td>126</td><td>180</td><td>Submission of Information Disclosure Stmt</td><td> </td></tr> <tr><td>581</td><td>40</td><td>581</td><td>40</td><td>Recording each patent assignment per property (times number of properties)</td><td> </td></tr> <tr><td>146</td><td>710</td><td>246</td><td>355</td><td>Filing a submission after final rejection (37 CFR § 1.129(a))</td><td> </td></tr> <tr><td>149</td><td>710</td><td>249</td><td>355</td><td>For each additional invention to be examined (37 CFR § 1.129(b))</td><td> </td></tr> <tr><td>179</td><td>710</td><td>279</td><td>355</td><td>Request for Continued Examination (RCE)</td><td> </td></tr> <tr><td>169</td><td>900</td><td>169</td><td>900</td><td>Request for expedited examination of a design application</td><td> </td></tr> <tr><td colspan="2"></td> <td colspan="4">Other fee (specify) _____</td> </tr> <tr> <td colspan="2" style="text-align: center;"><b>SUBTOTAL (1)</b> (\$)</td> <td colspan="4" style="text-align: center;"><b>SUBTOTAL (3)</b> (\$)</td> </tr> <tr> <td colspan="6" style="text-align: center;">*Reduced by Basic Filing Fee Paid</td> </tr> </tbody></table>				Fee Code	Large Entity		Small Entity		Fee Description	Fee Paid	Fee (\$)	Fee Code	Fee (\$)	Fee Code	105	130	205	65	Surcharge - late filing fee or oath		127	50	227	25	Surcharge - late provisional filing fee or cover sheet		139	130	139	130	Non-English specification		147	2,520	147	2,520	For filing a request for ex parte reexamination		112	920*	112	920*	Requesting publication of SIR prior to Examiner action		113	1,840*	113	1,840*	Requesting publication of SIR after Examination action		115	110	215	55	Extension for reply within first month		116	390	216	195	Extension for reply within second month		117	890	217	445	Extension for reply within third month		118	1,390	218	695	Extension for reply within fourth month		128	1,890	228	945	Extension for reply within fifth month		119	310	219	155	Notice of Appeal		120	310	220	155	Filing a brief in support of an appeal		121	270	221	135	Request for oral hearing		138	1,510	138	1,510	Petition to institute a public use proceeding		140	110	240	55	Petition to revive - unavoidable		141	1,240	241	620	Petition to revive - unintentional		142	1,240	242	620	Utility issue fee (or reissue)		143	440	243	220	Design issue fee		144	600	244	300	Plant issue fee		122	130	122	130	Petitions to the Commissioner		123	50	123	50	Processing fee under 37 CFR 1.17(q)		126	180	126	180	Submission of Information Disclosure Stmt		581	40	581	40	Recording each patent assignment per property (times number of properties)		146	710	246	355	Filing a submission after final rejection (37 CFR § 1.129(a))		149	710	249	355	For each additional invention to be examined (37 CFR § 1.129(b))		179	710	279	355	Request for Continued Examination (RCE)		169	900	169	900	Request for expedited examination of a design application				Other fee (specify) _____				<b>SUBTOTAL (1)</b> (\$)		<b>SUBTOTAL (3)</b> (\$)				*Reduced by Basic Filing Fee Paid					
Fee Code	Large Entity		Small Entity		Fee Description		Fee Paid																																																																																																																																																																																																			
	Fee (\$)	Fee Code	Fee (\$)	Fee Code																																																																																																																																																																																																						
105	130	205	65	Surcharge - late filing fee or oath																																																																																																																																																																																																						
127	50	227	25	Surcharge - late provisional filing fee or cover sheet																																																																																																																																																																																																						
139	130	139	130	Non-English specification																																																																																																																																																																																																						
147	2,520	147	2,520	For filing a request for ex parte reexamination																																																																																																																																																																																																						
112	920*	112	920*	Requesting publication of SIR prior to Examiner action																																																																																																																																																																																																						
113	1,840*	113	1,840*	Requesting publication of SIR after Examination action																																																																																																																																																																																																						
115	110	215	55	Extension for reply within first month																																																																																																																																																																																																						
116	390	216	195	Extension for reply within second month																																																																																																																																																																																																						
117	890	217	445	Extension for reply within third month																																																																																																																																																																																																						
118	1,390	218	695	Extension for reply within fourth month																																																																																																																																																																																																						
128	1,890	228	945	Extension for reply within fifth month																																																																																																																																																																																																						
119	310	219	155	Notice of Appeal																																																																																																																																																																																																						
120	310	220	155	Filing a brief in support of an appeal																																																																																																																																																																																																						
121	270	221	135	Request for oral hearing																																																																																																																																																																																																						
138	1,510	138	1,510	Petition to institute a public use proceeding																																																																																																																																																																																																						
140	110	240	55	Petition to revive - unavoidable																																																																																																																																																																																																						
141	1,240	241	620	Petition to revive - unintentional																																																																																																																																																																																																						
142	1,240	242	620	Utility issue fee (or reissue)																																																																																																																																																																																																						
143	440	243	220	Design issue fee																																																																																																																																																																																																						
144	600	244	300	Plant issue fee																																																																																																																																																																																																						
122	130	122	130	Petitions to the Commissioner																																																																																																																																																																																																						
123	50	123	50	Processing fee under 37 CFR 1.17(q)																																																																																																																																																																																																						
126	180	126	180	Submission of Information Disclosure Stmt																																																																																																																																																																																																						
581	40	581	40	Recording each patent assignment per property (times number of properties)																																																																																																																																																																																																						
146	710	246	355	Filing a submission after final rejection (37 CFR § 1.129(a))																																																																																																																																																																																																						
149	710	249	355	For each additional invention to be examined (37 CFR § 1.129(b))																																																																																																																																																																																																						
179	710	279	355	Request for Continued Examination (RCE)																																																																																																																																																																																																						
169	900	169	900	Request for expedited examination of a design application																																																																																																																																																																																																						
		Other fee (specify) _____																																																																																																																																																																																																								
<b>SUBTOTAL (1)</b> (\$)		<b>SUBTOTAL (3)</b> (\$)																																																																																																																																																																																																								
*Reduced by Basic Filing Fee Paid																																																																																																																																																																																																										
**or number previously paid, if greater; For Reissues, see above																																																																																																																																																																																																										

**SUBMITTED BY**

Name (Print/Type)	<b>Michael L. Dunn</b>	Registration No. <b>25,330</b> (Attorney/Agent)	Complete (if applicable)
Signature			Telephone <b>716-433-1661</b>
Date	<b>June 07, 01</b>		

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



PPR:135D US

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicants: Molly F. Kulesz-Martin

Art Unit: 1642

Serial No: 08/644,289

Filed: May 10, 1996

Examiner: M. Davis

For: p53as PROTEIN AND  
ANTIBODY THEREFOR

I certify that this REPLY BRIEF is being deposited on June 4, 2001 with the U.S. Postal Service as first class mail addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231

A handwritten signature in black ink, appearing to read "Michael L. Dunn".

Michael L. Dunn

Registration No. 25,330

**REPLY BRIEF**

Box AF  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

This is in reply to the Examiner's Answer dated May 24, 2001.

Many of the arguments raised by the Examiner are refuted by the original Brief on Appeal; however, a number of arguments in the Examiner's Answer are new or expanded.

The Examiner's statement that the brief does not contain a statement with respect to related appeals and interferences is not correct. The required statement is clearly given at the bottom of page 1 of the Brief.

The Examiner's statement with respect to grouping of claims is not agreed with and in any case is irrelevant. The Appellant has given reasons why the claims do not stand or fall together and why the claims may be considered independently patentable over the cited art. It is

thus the province of the Board, not the Examiner, to determine patentability of the claims and it is the province of the Board, not the Examiner, to determine whether the cited art applies (or does not apply) to the claims equally.

The Examiner's argument with respect to indefinite nature of the language "active wild type", in Claims 1, 3-6, 8-11, 17 and 18, disregards clear claim limitations that the activity referred to is "growth regulation". The Examiner may not broaden the claim language beyond its clear limits and then say that the broadening done by the Examiner is indefinite.

The Examiner's argument with respect to the "new matter" rejection of Claims 1, 3-6, 8-11, 17 and 18 is flawed for reasons similar to the above. Again the Examiner improperly interprets the claims beyond its clear limits and then says that the misinterpretation encompasses new matter. The claims clearly require that the claimed p53as be the same as p53 up to the final 50 carboxy terminal amino acids of p53. Any differences between p53 and p53as thus may not be before the final 50 carboxy terminal amino acids of p53. Despite this clear limitation, the Examiner says that the claims encompass new matter because an epitope different than p53 could be anywhere in p53as. That interpretation is illogical and is simply not possible and must disregard the clear requirement of identity up to the final 50 amino acids.

It has always been the position of the Appellant that the unique epitope in the p53as of the invention was there to distinguish p53as from p53. For the first time in the Examiner's answer, the Examiner has raised an argument that there is no disclosure in the specification that the epitope be unique with respect to all proteins. **This is a new argument first presented in the Examiner's Answer and as such is an untimely new ground of rejection that should be**

**presented as such to permit amendment.** No amendment in reply to the final rejection made any changes to the claims that would affect the nature of this new argument. The new argument therefore was not made necessary by any action on the part of the Appellants. In any case it is the position of the Appellants that the “unique epitope” referred to means unique as between p53 and p53as and has always been argued as such. Whether or not the epitope is unique as to all other proteins is essentially irrelevant with respect to the invention since the point is to distinguish between p53 and p53as.

In any case, as previously discussed in the brief and throughout prosecution, one skilled in the art, once given motivation by the present application, can easily add epitopes to the end of p53as to distinguish from p53. There is no new matter. If, however, the Board agrees with the Examiner that there is new matter, it is requested that a formal new rejection be given so as to allow the Appellants to amend.

The arguments made by the Examiner with respect to the art rejections have already been addressed in the brief. It is sufficient to simply reiterate that these rejections are classic hindsight. The references, no matter how they are combined simply do not suggest the invention. As an example, the Examiner uses classic hindsight logic by stating that because Han et al teaches that a part of a p53as (clearly not functional) in a plasmid for the purpose of study renders it obvious to incorporate a complete p53as into a plasmid for use as a vector. This is a clear quantum leap unsupported by the cited art. The Examiner makes an attempt to support such a position by saying that full length sequences for proteins other than p53as have been incorporated into plasmids for study and somehow that makes it obvious to incorporate a

sequence for a different (p53as) into a plasmid, not even for study, but for use as a vector. Such an argument is clearly improper.

In summary, none of the references cited by the Examiner in any of the rejections suggest incorporating p53as into anything and certainly not into a plasmid or viral vector. None of the cited references have this critical defect cured by anything disclosed in any of the other cited references.

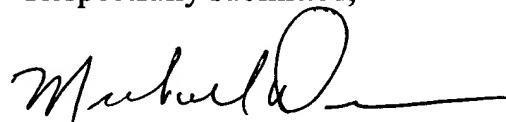
The rejections should be reversed.

Conclusion

In view of the foregoing, it is clear that the pending claims are definite, contain no new matter and are patentable over the cited prior art. Reversal of the Examiner and allowance of all claims are therefore respectfully requested.

Respectfully submitted,

Dated: June 4, 2001



Michael L. Dunn  
Attorney for Applicant(s)  
Reg. No. 25,330  
P.O.Box 96  
Newfane, New York 14108  
Telephone: (716) 433-1661